

Attorney Docket No. 5621 P1
Customer No. 49459

REMARKS

35 U.S.C. § 103(a) Rejections

Claims 1, 2, and 32 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over "Naphthalimide derivative JP 49-43688 (Noguchi 1), JP 47-12533 (Noguchi 2), GB 1003083 (Kasai), and GB 1054436 (Senshu)." Specifically, the Examiner reasoning is the following:

The prior art teaches similar compounds which have either the fluorescent whitening property or for improving the brightness. The prior art compounds may inherently also polymerize....Applicants main thrust is that the composition are not polymerizable and that only one benzene ring has a quaternary ammonium group. Again the superiority as claimed by Applicants is not convincing.

Moreover, the Examiner previously argued in the previous Office Action dated April 11, 2007 that one of ordinary skill in the art "would be motivated to modify the compounds with the different R groups to obtain the compounds of the invention."

Noguchi 1 teaches a naphthalimide containing composition wherein both benzene rings have a substituent containing a quaternary ammonium group. The compounds are used as fluorescent brightening agents for synthetic fibers. The compositions are not polymerizable.

Noguchi 2 teaches a naphthalimide containing composition wherein both benzene rings have a substituent containing a quaternary ammonium group. The compositions are used for fluorescent whitening of synthetic fibers. The compounds are used as fluorescent brightening agents for synthetic fibers. The compositions are not polymerizable.

Kasai teaches a naphthalimide containing composition wherein the benzene rings do not have a substituent containing a quaternary ammonium group and have only one substituent on one benzene ring. The compounds are for improving the brightness of polymeric materials by treatment of these compounds with the naphthalimide containing composition. The compositions are not polymerizable.

Senshu teaches a naphthalimide containing composition wherein the benzene rings do not have a substituent containing a quaternary ammonium group and have only one substituent on one benzene ring. The compounds are for optical whitening of synthetic organic material by treatment of these compounds with the naphthalimide containing composition. The compositions are not polymerizable.

Attorney Docket No. 5621 P1
Customer No. 49459

The present invention teaches a composition containing a naphthalimide containing fluorescent moiety. More specifically, there are two benzene groups in the naphthalimide and only one of them has a quaternary ammonium group.

Applicants traverse the Examiner's rejection. None of the references teach the claimed compound. Therefore, the Examiner has argued obviousness. The Applicants infer from the Examiner's rejection that crux of the rejection is based on structural similarity of the compounds and that one of ordinary skill in the art would be motivated to modify the prior art and make the claimed invention. Moreover, Applicants infer from the Examiner's comments that the previous analysis was not persuasive because "the prior art compounds may inherently polymerize" and that the claimed superior property is not convincing because of that fact.

"A *prima facie* case of obviousness based on structural similarity is rebuttable by proof that the claimed compounds possess unexpectedly advantageous or superior properties." MPEP 2144.09 (citing *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963)). Contrary to the Examiner's position, the prior art monomers are not polymerizable. Contrary to the prior art, the present invention teaches a composition containing a naphthalimide containing fluorescent moiety that is polymerizable and therefore possesses a superior property over the prior art compounds cited by the Examiner. Therefore, Applicants contend that the showing of a superior property of the claimed compound rebuts the rejection of obviousness based on structural similarity.

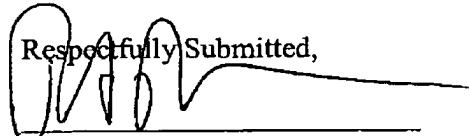
In view of the foregoing, Applicants request that pending claims 1, 2 and 32 are allowed.

Attorney Docket No. 5621 P1
Customer No. 49459

CONCLUSION

Applicants respectfully request that a Notice of Allowance be sent for all pending claims.

Respectfully Submitted,



Peter A. DiMattia, Reg. No. 59,138
Nalco Company
Patent and Licensing Department
1601 West Diehl Road
Naperville, IL 60563-1198

Date: 1/18/08